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MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: *Margaret A. Focarino*
Margaret A. Focarino
Deputy Commissioner
for Patent Operations

SUBJECT: Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

(1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

(2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

(3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.



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Re Patent Application of: KEVIN P. PARKER

Attorney's Docket No. PRKR-4100

Application No. 10/670,749

Group Art Unit: 3722

Filed September 25, 2003

Confirmation No. 2758

Examiner: Gates, Eric Andrew

For: **APPARATUS AND METHOD FOR BINDING A BOOK**

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a (1) *Response to Office Action Mailed January 25, 2007*; (2) Seven sheets of sketches; (3) *Petition for a One Month Extension of Time to Respond*; (4) *Patent Office Memorandum*; (5) *Return postcard* in the above-identified application.

The fee has been calculated as shown below.

	Claims Remaining After Amendment	Highest Number Previously Paid For	Present Extra	Rate	Additional Fee
Total	20	28	0	\$50	\$0
Independent	5	7	0	\$200	\$0
<input type="checkbox"/> First Presentation of Multiple Dependent Claims				\$360	\$0
Total					\$0
<input checked="" type="checkbox"/> Small Entity 50 percent Filing Fee Reduction (if applicable)					

- ☒ No additional fee is required.
- ☒ A check in the amount of \$60 is attached.
- ☒ Please charge any additional fees, including any fees necessary for extensions of time, or credit overpayment to Deposit Account No. 50-1697. **A duplicate copy of this sheet is enclosed.**
- ☐ Petition for extension of time. The undersigned attorney of record hereby petitions for an extension of time pursuant to 37 C.F.R. § 1.136(a), as may be required, to file this response.

GIRARD & EQUITZ LLP

May 25 2007
Date

By: 

Philip A. Girard
Registration Number 28,848
Attorney(s) or Agent(s) of Record

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 25, 2007.

Dated: 5-25-07

By: 

Jacob Zweig